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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/802,236	03/17/2004	Howard Marshall	P32422C1	5147

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EXAMINER

BERNHARDT, EMILY B

ART UNIT PAPER NUMBER

1624

DATE MAILED: 03/30/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/802,236

Applicant(s)

MARSHALL ET AL.

Examiner

Emily Bernhardt

Art Unit

1624

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 20 December 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11,14,17 and 18 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 10 and 18 is/are allowed.
- 6) ☒ Claim(s) 1-9,11,14,17 is/are rejected.
- 7) ☒ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

In view of applicants' response filed 12/20/04 the following still applies.

Claim 11 remains rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

1. The rejection of the previous action regarding the 2nd **optional** step in claim 11 appears to have been misinterpreted. The step is the one appearing on the 2nd last line of claim 11 and not route (b) which has been cancelled by applicants.

Claims 1-8,11,14 and 17 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the enablement requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention. The scope of Ra rings remain nonenabled for reasons of record. While applicants have amended the "heteroaryl" scope appearing in P1,P2 and P3 the scope still reads on further fused derivatives not supported by the working examples as set forth in the previous action.

Insertion of "monocyclic" in front of "aromatic ring containing..." for P1-P3 would overcome the rejection.

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 1-9,11,14 and 17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Gaster references for reasons of record. Applicants' traverse to this rejection is not persuasive for the following reasons. The cases cited by the examiner regarding H vs Me are still believed to be pertinent since it was the **closeness** in structural similarity between prior art and appealed compounds that was stressed by the Court in the affirming the PTO and thus sufficient motivation did exist to make methylated analogs **without** an express equivalency teaching. Such rationale was also applied in earlier decisions involving H vs 1 o2 Me's. See Ex parte Henkel 130 USPQ 474 and Ex parte Fauque 121 USPQ 425 in which a similar utility issue was never even a consideration.

Additionally, the remarks regarding expected steric effects with methyl in place of H which would force compounds into the boat conformer with expectant loss of activity is entirely speculative and thus fails to provide any evidence to support a legal conclusion of unobviousness.

The obviousness type double patenting rejections over claims 1-9,11,14,16 and 17 remains over the claims of US'122 and US'979. The examiner recognizes that the double patenting rejections are cumulative as the patentability of said

claims reside in a showing of patentable distinctness over the disclosures of the corresponding WO publications which have not been overcome.

However, the obviousness type double patenting rejection over claims in parent US'030 also remains for claims 1-9,14 and 17 and needs to be overcome by filing of a terminal disclaimer should said claims ever be otherwise in condition for allowance.


Claim 10 is allowed as well as new claim 18 which is limited to one species not particularly taught or suggested by the closest art applied herein.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Emily Bernhardt whose telephone number is 571-272-0664.

If attempts to reach the examiner by telephone are unsuccessful, the acting supervisor for AU 1624, James O. Wilson can be reached at 571-272-0661. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300.


Emily Bernhardt
Primary Examiner
Art Unit 1624